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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

5 In re application of: Tara Chand Singhal)
Serial No: 09/196,963) Art Unit
Filed: November 20, 1998) 2876
10 For: UNIVERSAL CHARITY CARD SYSTEM)
Examiner: St. CYR, DANIEL.)
15 Attorney Docket: 11195.10)

COMPLETE NEW APPEAL BRIEF

IN RESPONSE TO Notification of Non-Compliant Appeal Brief (37 CFR 41.37)

20 Commissioner for Patents
P O Box 1450, Alexandria, VA 22313-1450

Dear Sir:

25 This response is to Notification of Non-Compliant Appeal Brief (37 CFR 41.37),
dated 1/27/2006, having a shortened statutory period of one month from the Notice date.

The defects noted in the Notification have now been corrected and a complete new
Appeal Brief is being re-filed, as required within the statutory time period, on or before
2/27/2006.

30 **CERTIFICATE OF MAILING UNDER 37 CFR §1.8**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail,
postage prepaid, in an envelope addressed to: Mail Stop: Appeal Brief, Commissioner for Patents, P O Box 1450,
Alexandria, VA 22313-1450, on February 27/2006 by [Signature]
35 TARA CHAND SINGHAL, Applicant

APPEAL BRIEF

(1) REAL PARTY IN INTEREST

5 Same as identified in the caption of the brief.

(2) RELATED APPEALS AND INTERFERENCES

None

10 (3) STATUS OF CLAIMS

Claims 1-44 have been canceled without prejudice. Claims 45-74 have been rejected in a Final Office Action dated 5/7/2003. Claims 45-74 are pending in the Application and are the subject of this appeal.

15 (4) STATUS OF AMENDMENTS

An AMENDMENT AFTER FINAL UNDER 37 CFR 1.116 was filed on July 14, 2005 to incorrect informalities in some of the claims, viz, 47, 53, 54, 61 and 63, that were suggested by the examiner. Such an amendment after final, has been requested by the examiner in his notice of defects in appeal dated 3/24/05, and was thus timely filed. The
20 status of this amendment is unknown to the appellant at the time of filing of this appeal brief.

(5) SUMMARY OF INVENTION

Background

25 [Page 1, lines 23-28, Page 2, lines 1 to 28] In a prior art method of raising funds, benefactors of a charity, desiring to raise funds for the charity approach a merchant and buy gift certificates at a discount from the face value. The benefactors then sell the gift certificate at face value to other benefactors of the charity. The difference in the face value and the discount value is then given to the charity. The benefactors when
30 shopping at the merchant use the gift certificates. This method involves the considerable efforts such as: (i) the effort involved by the benefactors to approach the

merchant, buy the gift certificates from the merchant and in selling to the other benefactors, (ii) other benefactors have to shell out cash then to buy these gift certificates and use them in the future, (iii) the effort involved by the merchant in printing and selling the gift certificates. The present invention automates the system and method of charitable donation from the merchants to the charities at a local and national level, where the merchant is willing to make a donation to the charity from the sales to the benefactors of the charity.

Concise explanation of subject matter in claims involved in the appeal:

The following states a concise explanation of the subject matter defined in each of the independent claims involved in the appeal. The independent claims are: 45, 53, 61, and 72, for which a concise explanation is being identified here by reference to page number, line number, Figure number and by references numbers where applicable.

Claim 45 and dependent claims:

[Page 3, lines 4 to 27, page 4, lines 1 to 28, page 5, lines 2 to 8, page 6, lines 11 to 22] The invention discloses system and method for a Universal Charities Card System (UCCS) that enables the charities to efficiently collect charitable funds from those merchants who have agreed to donate a percent of sales to those benefactors of the charity who shop at the merchant. The UCCS system and method are facilitated by (i) a UCCS charitable system, (ii) a UCCS charitable card and a (iii) UCCS merchant software in the merchant computer system accessible in the merchant point of sale terminal.

[Page 4, lines 16 to 28, Page 8, lines 9 to 27, page 9, lines 1 to 24, Figure 1 and 4, references 15, 15A, 30, 31, 32, 33, 4, 35, 36, 37, 38, 39, 40, 41] The charitable system keeps data on charities, merchants, and customers and issues a charitable card. The card may be sent directly to the benefactor. Alternatively, the card may be sent to the charity, which then may distribute it to its benefactors. The charity system may aggregate donations across many merchants for many charities and make a consolidated transfer of funds to a charity on a periodic basis. Alternatively, large

merchants may choose to make their own fund transfer to a charity. The system may also prepare accounting statements for the charities, merchants and benefactors.

[Page 6, lines 24 to 28, page 7, lines 1 to 25, Figure 2, references 11, 16, 17, 18, 19] The charitable card encodes customer identifier and plurality of charities or charitable causes along with a percent split. The benefactor presents the charity-card to the merchant each time the benefactor patronizes the merchant. The merchant point of sale terminal reads the encoded information on the card.

[Page 3, lines 12 to 27, page 7, lines 14 to 28, page 8, lines 1 to 7, Figure 3, references 20, 25, 26, 27, 28, 29] The UCCS merchant software associates the encoded card information with an existing entry in a UCCS merchant database maintained by the software or creates a new entry. The UCCS software computes a charitable contribution as a percent of the current sale to the benefactor. The UCCS database maintains the data relevant to each transaction with the benefactor by date, charitable entity identification, charitable donations for each transaction, and cumulative donations. The UCCS merchant software can print on each sales receipt given to the benefactor, the names of charitable entities, donations for that transaction and cumulative donations from the prior sales transactions.

For each claimed means of claim 45, the identification is as follows:

Claim 45 element (a)

page 4, lines 16-28; page 5, lines 2 to 8;
page 6, lines 11 to 28; page 7, lines 1 to 5;
page 8, lines 12 to 27.

Claim 45 element (b)

page 3, lines 12 to line 27;
page 7, lines 8 to line 3 on page 8.

Claim 45 element (c)

page 4, lines 1 to 14;
page 8, lines 5 to 7.

Claim 53 and dependent claims:

[Page 3, lines 4 to 27, page 4, lines 1 to 28, page 5, lines 2 to 8, page 6, lines 11 to 22] The invention discloses system and method for a Universal Charities Card System (UCCS) that enables the charities to efficiently collect charitable funds from those merchants who have agreed to donate a percent of sales to those benefactors of the charity who shop at the merchant. The UCCS system and method are facilitated by (i) a UCCS charitable system, (ii) a UCCS charitable card and a (iii) UCCS merchant software in the merchant computer system accessible in the merchant point of sale terminal.

[Page 4, lines 16 to 28, Page 8, lines 9 to 27, page 9, lines 1 to 24, Figure 1 and 4, references 15, 15A, 30, 31, 32, 33, 4, 35, 36, 37, 38, 39, 40, 41] The charitable system keeps data on charities, merchants, and customers and issues a charitable card. The card may be sent directly to the benefactor. Alternatively, the card may be sent to the charity, which then may distribute it to its benefactors. The charity system may aggregate donations across many merchants for many charities and make a consolidated transfer of funds to a charity on a periodic basis. Alternatively, large merchants may choose to make their own fund transfer to a charity. The system may also prepare accounting statements for the charities, merchants and benefactors.

[Page 6, lines 24 to 28, page 7, lines 1 to 25, Figure 2, references 11, 16, 17, 18, 19] The charitable card encodes customer identifier and plurality of charities or charitable causes along with a percent split. The benefactor presents the charity-card to the merchant each time the benefactor patronizes the merchant. The merchant point of sale terminal reads the encoded information on the card.

[Page 3, lines 12 to 27, page 7, lines 14 to 28, page 8, lines 1 to 7, Figure 3, references 20, 25, 26, 27, 28, 29] The UCCS merchant software associates the encoded card information with an existing entry in a UCCS merchant database

maintained by the software or creates a new entry. The UCCS software computes a charitable contribution as a percent of the current sale to the benefactor. The UCCS database maintains the data relevant to each transaction with the benefactor by date, charitable entity identification, charitable donations for each transaction, and cumulative donations. The UCCS merchant software can print on each sales receipt given to the benefactor, the names of charitable entities, donations for that transaction and cumulative donations from the prior sales transactions.

For each claimed function of claim 53, the identification is as follows:

Claim 53 element (a)

page 4, lines 16-28; page 5, lines 2 to 4;
page 6, lines 11 to 28; page 7, lines 1 to 5;
page 8, lines 12 to 27.

Claim 53 element (b)

page 4, lines 23 to line 3 on page 5;
page 8, lines 17 to 20.

Claim 53 element (c)

page 4, lines 16 to 21;
page 6, line 24 to line 13 on page 7;
page 8, lines 22 to 27.

Claim 53 element (d)

Page 3, lines 12 to 23;
Page 6, lines 17 to 22;
Page 7, line 14 to line 7 on page 8.

Claim 61 and its dependent claims:

[Page 3, lines 4 to 27, page 4, lines 1 to 28, page 5, lines 2 to 8, page 6, lines 11 to 22] The invention discloses system and method for a Universal Charities Card System (UCCS) that enables the charities to efficiently collect charitable funds from those merchants who have agreed to donate a percent of sales to those benefactors of the charity who shop at the merchant. The UCCS system and method are facilitated by

(i) a UCCS charitable system, (ii) a UCCS charitable card and a (iii) UCCS merchant software in the merchant computer system accessible in the merchant point of sale terminal.

5 [Page 4, lines 16 to 28, Page 8, lines 9 to 27, page 9, lines 1 to 24, Figure 1 and 4, references 15, 15A, 30, 31, 32, 33, 4, 35, 36, 37, 38, 39, 40, 41] The charitable system keeps data on charities, merchants, and customers and issues a charitable card. The card may be sent directly to the benefactor. Alternatively, the card may be sent to the charity, which then may distribute it to its benefactors. The charity system
10 may aggregate donations across many merchants for many charities and make a consolidated transfer of funds to a charity on a periodic basis. Alternatively, large merchants may choose to make their own fund transfer to a charity. The system may also prepare accounting statements for the charities, merchants and benefactors.

15 [Page 6, lines 24 to 28, page 7, lines 1 to 25, Figure 2, references 11, 16, 17, 18, 19] The charitable card encodes customer identifier and plurality of charities or charitable causes along with a percent split. The benefactor presents the charity-card to the merchant each time the benefactor patronizes the merchant. The merchant point of sale terminal reads the encoded information on the card.

20 [Page 3, lines 12 to 27, page 7, lines 14 to 28, page 8, lines 1 to 7, Figure 3, references 20, 25, 26, 27, 28, 29] The UCCS merchant software associates the encoded card information with an existing entry in a UCCS merchant database maintained by the software or creates a new entry. The UCCS software computes a
25 charitable contribution as a percent of the current sale to the benefactor. The UCCS database maintains the data relevant to each transaction with the benefactor by date, charitable entity identification, charitable donations for each transaction, and cumulative donations. The UCCS merchant software can print on each sales receipt given to the benefactor, the names of charitable entities, donations for that transaction and
30 cumulative donations from the prior sales transactions.

For each claimed step of claim 61, the identification is as follows:

Claim 61 element (a)

page 4, lines 16-28; page 5, lines 2 to 8;
page 6, lines 11 to 28; page 7, lines 1 to 5;
5 page 8, lines 12 to 27.

Claim 61 element (b)

page 3, lines 12 to line 27;
page 7, lines 14 to line 24.

Claim 61 element (c)

10 page 4, lines 1 to 14;
page 7, line 14 to line 3 on page 8.

Claim 72 and its dependent claim:

The independent and dependent claims 72-73 function claims, the subject matter
15 as identified here by page number, line number and by references numbers where
applicable.

[Page 3, lines 12 to 27, page 7, lines 14 to 28, page 8, lines 1 to 7, Figure 3,
references 20, 25, 26, 27, 28, 29] The UCCS merchant software associates the
encoded card information with an existing entry in a UCCS merchant database
20 maintained by the software or creates a new entry. The UCCS software computes a
charitable contribution as a percent of the current sale to the benefactor. The UCCS
database maintains the data relevant to each transaction with the benefactor by date,
charitable entity identification, charitable donations for each transaction, and cumulative
donations. The UCCS merchant software can print on each sales receipt given to the
25 benefactor, the names of charitable entities, donations for that transaction and
cumulative donations from the prior sales transactions.

For each claimed function of claim 72, the identification is as follows:

page 3, lines 20 to 23;
30 page 7, lines 26 to line 3 on page 8.

(6) ISSUES

ISSUE #1:

5 Examiner in his office action dated 5/4/2004 has rejected claims 45-71 and 74, under 35 USC 103(a) Obviousness Rejection as being unpatentable over Pekka EP Patent No. 0 623 235, and in view of Derwent application AU 676819.

Appellant submits such rejection is improper under 35 USC 103(a) and Graham v. Deere which governs determination of obviousness by the USPTO.

10 **ISSUE #2:**

Examiner in his response dated 5/4/2004 has rejected claims 72-73 as being anticipated under 35 USC 102(b) by Pekka, WO 93/14476.

15 Appellant submits such rejection is improper under 35 USC 102(b) as the examiner mis-characterizes the disclosure in Pekka in regard to this anticipated rejection of claims 72 –73.

(7) GROUPING OF CLAIMS

20 The following groups of claims do not stand and fall together:

- (i) System Claims are grouped as 45-52
- (ii) Function claims are grouped as 53-60
- (iii) Method claims are grouped as 61-71
- 25 (iv) System claims 72-74

(8) ARGUMENT

ISSUE #1:

5 Examiner in his office action dated 5/4/2004 has rejected claims 45-71 and 74, under 35 USC 103(a) Obviousness Rejection as being unpatentable over Pekka EP Patent No. 0 623 235, and in view of Derwent application AU 676819.

 Appellant submits such rejection is improper under 35 USC 103(a) and Graham v. Deere which governs determination of obviousness by the USPTO.

10 The two items of prior art that are cited by the examiner are:

Prior Art Item (1)

 Pekka, discloses, a system, where, an individual is choosing to make charitable contributions to a charity and is merely using the incident of a purchase transaction with a merchant to tender extra money than required for the purchase, intending to give the extra money as a charitable contribution and the merchant forwarding the individual's contributions to the charity, the identification of the charity being facilitated by a charity card on which the charity information is encoded and the charity card is presented to the merchant at the point of sale.

20 Prior Art Item (2) Derwent application AU 676819

 Basic-Abstract:

 The method of commerce involves causing the participating merchant to provide a rebate/discount to participating purchasers, and enabling the participating merchants to facilitate passage of the purchaser's funds to a charity or similar organization. Upon each or selected transactions between the participating merchants and participating purchasers, participating purchaser's funds to the value of the provided rebate/discount are passed to the charity as a donation from the participating purchaser.

30 The transactions are conducted through an electronic funds transfer network which is able to operatively access the necessary account records of the participating

merchants, the participating purchaser's, a participating charity and determine the amount of rebate/discount provided by each participating merchant. The funds are donated to charity so that the donations constitute tax-deductible donations for the purchasers.

5

Distinguishing Pekka and Derwent:

Any person can make a donation to a charity of his/her choice at any time by sending a check or other means of transferring funds to the charity. Alternatively, in the prior art such as Pekka, the person may find it more convenient to make a donation to a charity of choice when the person is shopping at a merchant. Then at the time of the sale transaction, the person can offer extra money in addition to the purchase amount to the merchant and request the merchant to forward such extra monies to the charity of the person's choice.

Such charity giving by the person can be facilitated via a charity card that the person carries with him/her. The card identifies the charity to which the funds are to be sent. The merchant may read the card electronically to identify and record donations to the charity and is choosing to do provide this convenience to the person. Prior art patents disclose such a system.

In Pekka, the customer is choosing to make a donation to a charity out of own his/her own personal funds and merely as a matter of convenience uses the customer merchant sale/purchase interface to forward those funds to the charity via a charity card encoded with charity identification depending upon the merchant to collect these additional monies and forward them to the charity.

25

Derwent, prior art disclosure is just like Pekka disclosure, where the shopper is donating his own funds to a charity and choosing a sale/purchase transaction with the merchant to facilitate such charity giving. Derwent abstract is reproduced below with two features highlighted in bold:

30

The method of commerce involves causing the participating merchant to provide a rebate/discount to participating purchasers, and enabling the participating merchants to facilitate passage of the purchaser's funds to a charity or similar organization. Upon each or selected transactions between the participating merchants and participating purchasers, **participating purchaser's funds to the value of the provided rebate/discount are passed to the charity as a donation from the participating purchaser.**

The transactions are conducted through an electronic funds transfer network which is able to operatively access the necessary account records of the participating merchants, the participating purchaser's, a participating charity and determine the amount of rebate/discount provided by each participating merchant. **The funds are donated to charity so that the donations constitute tax-deductible donations for the purchasers.**

Derwent clearly makes the following important disclosures:

- (1) The funds being donated are the purchaser's funds and not the merchant's funds.
- (2) Donations constitute tax-deductible donations for the purchasers.

Therefore, Appellant submits that the Derwent is no different than Pekka in its disclosure. In both of these prior arts, Pekka and Derwent, the customer/purchaser/donor's own funds are being donated to the charity and being collected by the merchant on behalf of the donor as a matter of convenience to the donor.

In contrast, in the current invention, the claim group 45-52 is for a charity system facilitating contributions from a merchant to a charitable entity using means clauses. The independent claim 45 provides:

45. A charity system facilitating contributions from a merchant to a charitable entity comprising:

- a. first means for making available a charity card with encoded charity identification to a select group of public desiring to benefit the entity;
- 5 b. second means for a merchant computer system with a sale terminal, on being presented the charity card, reading the encoded charity card, computing a contribution by multiplying a sale amount and a percent of sale and allocating the contribution to the entity, wherein the merchant will contribute to the entity the percent of sales of the merchant to the select group;
- 10 c. third means for aggregating the allocated contributions from a plurality of sale transactions with the select group and sending the aggregate contributions to the entity.

The claim 45 has element (b) that is not taught by Pekka or Derwent. Specifically element (b) states that the merchant makes a contribution from the proceeds of the
15 sales of the merchant as a percent of sales. In Pekka and Derwent, the contribution is by the customer of customer's own funds.

In the current invention, when a merchant pays a charitable contribution out of merchant's sales to only a select group of public desiring to benefit a charity, (element
20 (a)), and not public at large or all of merchant's shoppers, it creates a relationship of goodwill between the charity, the merchant and the select group of public, where the select group is loyal to the merchant for shopping and making purchases from the merchant.

25 In contrast, in Pekka and Derwent no such relationship is created, where a sales purchase transaction is merely a convenient event for the customer to make a contribution of his/her own funds to a charity. Hence, the scope and content of prior art and the differences between the claimed invention and the prior art are such that the current invention has an entirely different scope than the prior art.

30 Graham v. Deere, governs the application of 35 USC 103(a), at US PTO. Under the four part Graham inquiry, "The underlying factual inquiries include [1] the scope and

content of the prior art; [2] the differences between the claimed invention and the prior art; [3] the level of ordinary skill in the art; and [4] objective evidence of nonobviousness, including commercial success, copying, and long-felt need.” State Contr. & Eng'g Corp. v. Condotte America, Inc., 346 F.3d 1057, 1068 (Fed. Cir. 2003), citing Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966).

Appellant submits, that under factual inquiries [1] that the scope and content of prior art and [2] the differences between the claims of this invention and prior art is such that an obviousness rejection has no grounds. In view of these arguments, claim 45 is not obvious over the cited combination of the prior art. Dependent claims are likewise not obvious over the cited combination of the prior art. Therefore, the obviousness rejection fails the Graham v. Deere test.

In the current invention, the claim group 53-61 is for a charity system facilitating contributions from a merchant to a charitable entity using function clauses. The independent claim 53 provides:

53. A charity system facilitating contributions from a merchant to a charitable entity comprising:

- a. a first function for receiving and storing entity data of entities willing to influence a select group of public to patronize merchants who are willing to contribute a percent of their sales to the entities;
- b. a second function for receiving and storing data of members of select group desiring to patronize merchants willing to contribute to the entities;
- c. a third function printing and mailing a charity card encoded with charity identification and member identification to the members of select group;
- d. a fourth function in a merchant computer system with a sale terminal enabling reading the charity card and computing a contribution as a percent of sale and storing said contribution data identified by entity identification and member identification into a merchant database.

This claim 53 has element (c) that is not taught by Derwent and elements (d) that is not taught by Pekka. Specifically element (c) states that the charity card is encoded with charity identification and customer identification and element (d) states that the merchant makes a contribution from the proceeds of the sales of the merchant as a percent of sales. In Pekka, the charity card is encoded with charity identification and in Pekka and Derwent, the contribution is by the customer of customer's own funds.

In the current invention, when a merchant pays a charitable contribution out of merchant's sales to only a select group of public desiring to benefit a charity, (element (a)), and not public at large or all of merchant's shoppers, it creates a relationship of goodwill between the charity, the merchant and the select group of public, where the select group is loyal to the merchant for shopping and making purchases from the merchant.

In contrast, in Pekka and Derwent no such relationship is created, where a sales purchase transaction is merely a convenient event for the customer to make a contribution of his/her own funds to a charity. Hence, the scope and content of prior art and the differences between the claimed invention and the prior art are such that the current invention has an entirely different scope than the prior art.

Graham v. Deere, governs the application of 35 USC 103(a), at US PTO. Under the four part Graham inquiry, "The underlying factual inquiries include [1] the scope and content of the prior art; [2] the differences between the claimed invention and the prior art; [3] the level of ordinary skill in the art; and [4] objective evidence of nonobviousness, including commercial success, copying, and long-felt need." *State Contr. & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1068 (Fed. Cir. 2003), citing Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966).

Appellant submits, that under factual inquiries [1] that the scope and content of prior art and [2] the differences between the claims of this invention and prior art is such that an obviousness rejection has no grounds. In view of these arguments, claim 53 is

not obvious over the cited combination of the prior art. Dependent claims are likewise not obvious over the cited combination of the prior art. Therefore, the obviousness rejection fails the Graham v. Deere test.

5 In the current invention, the claim group 61-71 is for a method for facilitating contributions from a merchant to a charitable entity using steps. The independent claim 61 provides:

61. A method facilitating contributions from a merchant to a charitable entity
10 comprising the steps of:
a. making available to a select group of public desiring to benefit the entity a charity card with encoded entity identification;
b. receiving by the merchant at a merchant computer system with a sale terminal the charity card by members of the select group; and
15 c. reading by the merchant sale terminal of the charity card, computing a contribution by multiplying a sale amount and a percent of sale and allocating the contribution to the entity, wherein the merchant will contribute to the entity the percent of sales of the merchant to the select group.

20 This claim 61 has element (c) that is not taught by Pekka and Derwent.

Specifically element (c) states that the merchant makes a contribution from the proceeds of the sales of the merchant as a percent of sales. In Pekka and Derwent, the contribution is by the customer of customer's own funds.

25 In the current invention, when a merchant pays a charitable contribution out of merchant's sales to only a select group of public desiring to benefit a charity, (element (a)), and not public at large or all of merchant's shoppers, it creates a relationship of goodwill between the charity, the merchant and the select group of public, where the select group is loyal to the merchant for shopping and making purchases from the
30 merchant.

In contrast, in Pekka and Derwent no such relationship is created, where a sales purchase transaction is merely a convenient event for the customer to make a contribution of his/her own funds to a charity. Hence, the scope and content of prior art and the differences between the claimed invention and the prior art are such that the current invention has an entirely different scope than the prior art.

Graham v. Deere, governs the application of 35 USC 103(a), at US PTO. Under the four part Graham inquiry, "The underlying factual inquiries include [1] the scope and content of the prior art; [2] the differences between the claimed invention and the prior art; [3] the level of ordinary skill in the art; and [4] objective evidence of nonobviousness, including commercial success, copying, and long-felt need." *State Contr. & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1068 (Fed. Cir. 2003), citing Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966).

Appellant submits, that under factual inquiries [1] that the scope and content of prior art and [2] the differences between the claims of this invention and prior art is such that an obviousness rejection has no grounds. In view of these arguments, claim 61 is not obvious over the cited combination of the prior art. Dependent claims are likewise not obvious over the cited combination of the prior art. Therefore, the obviousness rejection fails the Graham v. Deere test.

In the current invention, the claim 74 is a dependent claim dependent upon claim 72.. The independent claim 72 provides:

72. A sales receipt printed for a customer by a merchant sales terminal, wherein the sales receipt comprising: on the face of the sales receipt, identification of a charitable entity along with an amount of contribution to the entity by the merchant.

This dependent claim 74 has elements that are not taught by Pekka or Derwent. See also arguments for **Issue 2** on claims 72-73.

Specifically, the differences between claim 74 and Pekka or Derwent are that the merchant does not print on a sales receipt to a particular customer the cumulative contributions to a specific charity(s) based on sales to that customer as in this invention.

5 When a customer sees printed on the sales receipt the amount of money being given to a charity of his/her choice, by the merchant, it acts as an immediate motivating factor creating a good will for the merchant, from which the merchants benefit by building loyalty.

10 Graham v. Deere, governs the application of 35 USC 103(a), at US PTO. Under the four part Graham inquiry, "The underlying factual inquiries include [1] the scope and content of the prior art; [2] the differences between the claimed invention and the prior art; [3] the level of ordinary skill in the art; and [4] objective evidence of nonobviousness, including commercial success, copying, and long-felt need." State Contr. & Eng'g Corp.
15 v. Condotte America, Inc., 346 F.3d 1057, 1068 (Fed. Cir. 2003), citing Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966).

 Appellant submits, that under factual inquiries [1] that the scope and content of prior art and [2] the differences between the claims of this invention and prior art is such that an obviousness rejection has no grounds. In view of these arguments, claim 72 is
20 not obvious over the cited combination of the prior art. Dependent claims are likewise not obvious over the cited combination of the prior art. Therefore, the obviousness rejection fails the Graham v. Deere test.

 In conclusion on this issue, Appellant submits that the scope and content of prior
25 art as described above and the differences between the claims of this invention and prior art are such that an obviousness rejection has no grounds. Hence claims 45-71 and 74 are not obvious over the cited combination of Pekka and Derwent and do not satisfy the Graham v. Deere test for obviousness.

ISSUE #2:

Examiner in his response dated 5/4/2004 has rejected claims 72-73 as being anticipated under 35 USC 102(b) by Pekka, WO 93/14476.

5 Appellant submits such rejection is improper under 35 USC 102(b) as the examiner mis-characterizes the disclosure in Pekka in regard to this anticipated rejection of claims 72 –73.

10 Examiner mis-characterizes the disclosure in Pekka in regard to this anticipated rejection of claims 72 –73 as follows:

Examiner states “ Pekka discloses a method for making and collecting donation comprising: means for giving charity cards 12 to donors, the charity cards having identification information for both the users and the charities (in order for the card to include the user, a registration must be made); a cash register 16 for collecting
15 donation; a central computer 22 linking the cash register; the collected donation may be electronically transferred or generating a check to the charity; and the donation contribution is printed on the sale receipt. (See pages 6-9, and 15, last paragraph).”

Appellant reproduces the last paragraph on page 15 of Pekka here:

20 Pekka, Page 15, last paragraph, “For example, if the code in question is “011111222229”, (UPC-A), when this code is entered into the system and stored in mass storage, the code informs the software that the donation value is fixed at \$10.00, and transfers this fixed donation amount to the computer-based cash terminal. This software also extracts the additional instructions that, when this particular code is
25 entered, the cash register should show on its display monitor the text “Donation American Cancer Society \$10.00” and later print this line of text on the donor’s receipt.”

Appellant’s Arguments:

30 Pekka teaches that the customer/donor is making a donation out of his own funds and relies on the merchant, as a matter of mere convenience, to collect

customer's own funds and forward the same to the charity. The merchant gives the donor a donation receipt for the donor's donation.

5 It is customary for many merchants to display near their check out counters pre-configured charity cards, for amounts such as Five dollars or Ten dollars for Food for Hunger Programs etc. The donors desiring to donate pick up one or more these pre-configured charity cards from the display and present it to the checkout clerk. These cards have UPC codes, like any other merchandize, which the merchant computer systems recognize. The merchant clerk scans them into the register. The receipt, that is
10 printed based on scanning the UPC code, shows the identification of the merchandize (name of the charity) and the merchandize price (donated amount such as Five or ten dollars).

15 What Pekka discloses in last paragraph of page 15 of Pekka is no different than what is described above. In Pekka, donor is making a donation out of donor's own funds that the donor tenders at the merchant checkout counter, and for which the donor gets a receipt as described above.

20 Claim 72 is copied here, with highlights in bold.

72. A sales receipt printed for a customer by a merchant sales terminal, wherein the sales receipt comprising: on the face of the sales receipt, identification of a charitable entity along with **an amount of contribution to the entity by the merchant.**

25 In contrast, claim 72, as copied above with highlight is wholly different and distinguishable from Pekka for the following reasons:

(1). The last line of claim 72 states, as highlighted in bold, "an amount of contribution to the entity by the merchant."

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(2) In Pekka, the sales receipt shows a donor's donation as a merchandize line item as part of other merchandise line items that are added up to a total dollar amount on the sales receipt and which the customer pays.

5 In contrast, claim 72 identifies not a line item of purchase for donor's donation, but an identification of funds donated by the merchant, that are not part of sales item total. Since the language of claim 72 identified the funds as amount of contribution by the merchant, they are not and cannot be a line item on the sales receipt and are not part of sales receipt total, as in Pekka. Hence, claim 72 is wholly different than what
10 Pekka discloses.

(3) In the current invention as claimed in claim 72, the donated funds that are listed on the receipt are merchant's funds, the amount being decided by the merchant, and not donor's funds, and the receipt is not used for claiming a tax deduction by the
15 donor but to generate and reinforce goodwill for the merchant in helping a charity of donor's choice.

To anticipate a claim for a patent, a single prior are reference must contain all its essential elements. "Federal Circuit decisions repeatedly emphasize that anticipation
20 (lack of novelty) is established only if (1) all the elements of an invention, as stated in a patent claim, (2) are identically set forth, (3) in a single prior art reference." Chisum on Patents § 3.02 (2003).

Hence, the donation of donor's own funds by a donor at the merchant check out, and getting a receipt for the same, as a line item of purchase, as in Pekka, is wholly
25 different than the Merchant donating merchant's own funds to a charity of customer's choice and printing that donation amount on the sales receipt, as in claim 72 and defeats anticipation. Therefore, Appellant submits that the cited reference of Pekka does not anticipate claim 72 and dependent claim 73.

30

(9) APPENDIX

Claims involved in this appeal are:

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45. A charity system facilitating contributions from a merchant to a charitable entity comprising:

a. first means for making available a charity card with encoded charity identification to a select group of public desiring to benefit the entity;

10 b. second means for a merchant computer system with a sale terminal, on being presented the charity card, reading the encoded charity card, computing a contribution by multiplying a sale amount and a percent of sale and allocating the contribution to the entity, wherein the merchant will contribute to the entity the percent of sales of the merchant to the select group;

15 c. third means for aggregating the allocated contributions from a plurality of sale transactions with the select group and sending the aggregate contributions to the entity.

46. The charity system as in claim 45, wherein the first means comprising:

a. means for members of the select group registering into the charity system;

20 b. means for the charity system printing the charity card identifying the entity by an encoding means and mailing the charity cards to members of the select group.

47. The charity system as in claim 45, wherein the first means comprising:

25 a. means for registering the entity and members of the select group into the charity system;

b. means for the charity system printing the charity card identifying the entity and the members of the select group by an encoding means and mailing the charity cards to the entity for distribution to the select group.

48. The charity system as in claim 45, wherein the second means comprising:
means for the merchant sale terminal printing a sales receipt identifying the entity and
the contribution to the entity from the sale transaction.

5 49. The charity system as in claim as in 45, wherein the second means comprising:
means for the merchant sales terminal printing a sales receipt identifying the entity, the
contribution to the entity from this sale transaction, and the cumulative contributions
from prior sales transactions.

10 50. The charity system as in claim 45, wherein the third means comprising:
a. means for collecting contributions from a plurality of merchants allocated to
plurality of entities;
b. means for aggregating contributions for entity and performing one electronic fund
transfer to entity bank.

15

51. The charity system as in claim as in 50, further comprising: means for preparing
and sending the entity an accounting statement, identifying the merchant and the
contribution from the merchant.

20 52. The charity system as in claim as in 50, further comprising: means for preparing
and sending to the merchant an accounting statement, identifying each of the entities
and the contribution from the merchant.

25 53. A charity system facilitating contributions from a merchant to a charitable entity
comprising:

a. a first function for receiving and storing entity data of entities willing to influence a
select group of public to patronize merchants who are willing to contribute a percent of
their sales to the entities;
b. a second function for receiving and storing data of members of select group
30 desiring to patronize merchants willing to contribute to the entities;

- c. a third function printing and mailing a charity card encoded with charity identification and member identification to the members of select group;
- d. a fourth function in a merchant computer system with a sale terminal enabling reading the charity card and computing a contribution as a percent of sale and storing said contribution data identified by entity identification and member identification into a merchant database.

54. The charity system as in claim 53, further comprising:

- a. a fifth function reading the merchant databases from a plurality of merchants and aggregating the contributions to the entity by the merchants;
- b. a sixth function performing a fund transfer of aggregate contributions from the merchants to the entities.

55. The charity system as in claim 53, wherein the second function comprising: receiving and storing a plurality of charitable entity identifications and percent split of contributions between the plurality of charitable entities.

56. The charity system as in claim 55, wherein the charity card additionally encoded with a plurality of entity identifications along with the percent split of contributions.

57. The charity system as in claim 56, wherein the fourth function comprising: splitting the contribution among the plurality of entities and storing said contribution data in the merchant database.

58. The charity system as in claim 57, wherein the fourth function comprising: a sub-function that prints on a sales receipt the entities and the contributions to the entities from the sale transaction.

59. The charity system as in claim 53, wherein the fourth function comprising: a sub-function that prints on a sales receipt the entity and the contribution to the entity from the sale transaction.

60. The charity system as in claim 53, wherein the fourth function comprising:
a sub-function that prints on a sales receipt the contribution to the entity from this sale
transaction and cumulative contribution from prior sales transactions.

5

61. A method facilitating contributions from a merchant to a charitable entity
comprising the steps of:

a. making available to a select group of public desiring to benefit the entity a charity
card with encoded entity identification;

10 b. receiving by the merchant at a merchant computer system with a sale terminal
the charity card by members of the select group; and

c. reading by the merchant sale terminal of the charity card, computing a
contribution by multiplying a sale amount and a percent of sale and allocating the
contribution to the entity, wherein the merchant will contribute to the entity the percent of
15 sales of the merchant to the select group.

62. The method as in claim 61, comprising the step of:

aggregating by the merchant the allocated contributions from a plurality of sale
transactions and sending the contributions to the entity.

20

63. The method as in claim 61, comprising the steps of:

a. registering by the entity and members of the select group into a universal charity
card system;

25 b. printing by the system, the card identifying the entity and the members of the
select group by an encoding means and mailing the charity cards to the entity for
distribution to the select group.

64. The method as in claim 63, comprising the step of:

30 printing by the system, the charity card identifying the entity and a member of the
select group by an encoding means and mailing the charity cards to the members of the
select group.

65. The method as in claim 61 comprising the steps of:

- a. registering by the entity itself into a universal charity card system; and
- b. notifying by the entity of the select group to obtain from the system the charity card identifying the entity and a member of the select group.

66. The method as in claim 61, comprising steps of:

- a. collecting contributions by the system from a plurality of merchants allocated to plurality of entities;
- b. aggregating by the system contributions for the entity and performing one fund transfer to an entity bank.

67. The method as in claim 66, comprising the step of: preparing and sending by the system to the entity an accounting statement, identifying the merchant and the contribution from the merchant.

68. The method as in claim 66, comprising the step of: preparing and sending by the system to the members of the select group of public an accounting statement identifying the charity and the contribution from the select member purchases from the merchant

69. The method as in claim 66, comprising the step of: preparing and sending by the system to the merchant an accounting statement, identifying each of the entities and the contribution from the merchant.

70. The method as in claim 61, comprising the step of: printing by the merchant sale terminal a sales receipt identifying the contribution to the entity from the sale transaction.

71. The method as in claim 61, comprising the step of: printing by the merchant sales terminal a sales receipt identifying the contribution to the entity from this sale transaction, and the cumulative contributions from prior sales transactions.

72. A sales receipt printed for a customer by a merchant sales terminal, wherein the sales receipt comprising: on the face of the sales receipt, identification of a charitable entity along with an amount of contribution to the entity by the merchant.

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73. The claim as in 72, wherein the identification of a charitable entity comprising: identification of at least one charitable cause.

74. The claim as in 72, wherein the amount of contribution comprises: an amount of
10 contribution from a present sales transaction and an amount of contribution from prior sales transactions.

CONCLUSION

5 Appellant submits, based on the arguments presented in this appeal, the current invention is entirely of a different scope and the current invention claims 45-71 and 74 are not obvious under section 35 USC 103(a) and Graham v. Deere test over Pekka and Derwent. Further, based on arguments presented in this appeal, claims 72-73 are not anticipated by Pekka, under 35 USC 102 (b).

10 Dated this the 27th day of February, 2006

Respectfully submitted,

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